

REMARKS

As a preliminary matter, Applicant appreciated the opportunity to discuss this patent application and the pending claims with the Examiner during the August 09, 2005 telephone interview. This response and the Request for Continued Examination (RCE) filed herewith is a result of that telephone interview. More particularly, claims 1-18 were originally pending. Please amend the claims 1, 7, and 13. Please add claims 19 and 20. No claims have been canceled. Accordingly, claims 1-20 are currently pending.

In view of these claim amendments and at the following remarks, withdrawal of the outstanding rejections to the pending claims is respectfully requested.

35 USC §102 Rejections

Claims 1-6 and 13-18 stand rejected under 35 USC §102(e) as being anticipated by U.S. Patent No. 5,867,164 to Bornstein et al. ("Bornstein"). These rejections are traversed.

It is a fundamental principal of patent law that to anticipate a claim, a single reference must teach each and every element of the claim as set forth in the claim. (MPEP §2131). Bornstein does not explicitly or inherently describe each and every element of pending claims 1-6 and 13-18 for the following reasons.

Claim 1 recites "a computer-implemented method comprising: accessing a document", "constructing, using a phase summarizing process, a sentence-based summary of writings of the document from the writings",

1 "locating a file associated with the document", "inserting the sentence-
2 based summary into the file such that the sentence-based summary is before
3 an opening paragraph of the document", and "saving the file." These
4 claimed features are not anticipated by Bornstein for the following reasons.

5 In addressing claim 1, the Action at section 6, asserts that "the
6 Bornstein reference to the top sentence, which includes information
7 regarding the document, being displayed in a display element is indication
8 of a sentence base summary of document as illustrated in applicants claim
9 language". Applicant respectfully disagrees.

10 Bornstein's presentation of information in a display element does not
11 explicitly or inherently describe "inserting" anything into the document
12 from which the top sentence was derived. Bornstein merely describes
13 independently generating a top sentence from a document, displaying
14 information representing document content in a user interface (i.e., the
15 display element), and displaying the top sentence in the display element.
16 When Bornstein describes that information representing document content
17 is presented in a user interface, and further describes displaying a top
18 sentence derived from analysis of the document in that same user interface,
19 this does not mean, without any additional description—description that is
20 clearly missing from Bornstein—that the actual document was edited or
21 modified to insert the top sentence into that document. This is especially
22 the case since Bornstein is completely silent on any such "inserting" into
23 the document.

24 In view of the above, a system of Bornstein may never
25 "constructing, using a phase summarizing process, a sentence-based

1 summary of writings of the document from the writings", "locating a file
2 associated with the document", "inserting the sentence-based summary into
3 the file such that the sentence-based summary is before an opening
4 paragraph of the document", and "saving the file", as claim 1 recites.

5 Accordingly, the 35 USC §102(e) rejection of claim 1 as anticipated
6 by Bornstein is improper and should be withdrawn.

7 Claims 2-6 depend from claim 1 and are allowable over Bornstein
8 solely by virtue of this dependency.

9 Accordingly, the 35 USC §102(e) rejections of claims 2-6 are
10 improper and should be withdrawn.

11 Claim 13 recites "accessing a document", "constructing a textual
12 content-based summary of writings of the document from the writings",
13 "inserting the textual content-based summary into the document such that
14 the textual content-basis summary is before an opening paragraph of the
15 document and on a common page with starting content of the document",
16 and "saving the document." For the reasons already discussed above with
17 respect to claim 1, Bornstein does not anticipate these features of claim 13.

18 Accordingly, the 35 USC §102(e) rejection of claim 13 is improper
19 and should be withdrawn

20 Claims 14-18 depend from claim 13 and are allowable over
21 Bornstein solely by virtue of this dependency.

22 Accordingly, the 35 USC §102(e) rejection of claims 14-18 should
23 be withdrawn
24
25

1 **35 USC §103 Rejections**

2 Claims 7-12 stand rejected under 35 USC §103(a) as being
3 unpatentable over Bornstein in view of Stark et al., "The Working Word",
4 PC Magazine, p. 487, Oct. 16, 1990 (hereinafter referred to as "Stark").
5 These rejections are traversed.

6 Claim 7 recites "evaluating words in the document to identify
7 ordered sets of words that appear repeatedly in a same order", "ranking
8 individual sentences in the document by treating the ordered sets of words
9 as if they were single words", "generating the summary based at least in
10 part on the sentence rankings", "inserting the summary into a file
11 comprising the document", and "saving the file to non-volatile data
12 storage."

13 Bornstein in view of Stark does not teach or suggest these claimed
14 features at least for the following reasons.

15 In addressing claim 7, the Action points to Bornstein's teaching of
16 "determining the significance of particular words and/or sentences, usually
17 by focusing on position in the document, semantic relationships, and term
18 frequencies" to conclude that Bornstein teaches "identify ordered sets of
19 words that appear repeatedly in a same order", as claim 7 recites. Applicant
20 respectfully disagrees.

21 Bornstein's teaching that word significance is a function of
22 document positions, semantic relationships, and term frequencies does not
23 teach or suggest "identify ordered sets of words that appear repeatedly in a
24 same order", as claim 7 recites. This is especially the case since Bornstein,
25 with the exception of teaching that a "window instantaneously updates to

1 *display a summary with more or less detail and in the same order as the*
2 *original document"* [emphasis added], is completely silent with respect to
3 "the same order" of anything else. As such, Bornstein's broad teaching that
4 word significance is a function of document positions, semantic
5 relationships, and term frequencies does not warrant modification by the
6 Action to arrive at the claimed "evaluating words in the document to
7 identify ordered sets of words that appear repeatedly in a same order", as
8 claim 7 recites.

9 The Action does not rely on Stark for "evaluating words in the
10 document to identify ordered sets of words that appear repeatedly in a same
11 order", as claim 7 recites. Moreover, Stark is completely silent with respect
12 to these claimed features.

13 In view of the above, a prima facie case of obviousness of claim 7
14 over Bornstein in view of Stark has not been presented. For this reason
15 alone, the 35 USC §103(a) rejection of claim 7 over Bornstein in view of
16 Stark is improper and should be withdrawn.

17 Additionally, the Action's modification to Bornstein is not supported
18 by way of prior art citation, common knowledge in the art, or cited legal
19 precedent. Thus, this unsupported modification to Bornstein is seemingly
20 either a result of personal knowledge or being made with impermissible
21 hindsight reconstruction of the features of claim 7. "When a rejection in an
22 application is based on facts within the personal knowledge of an employee
23 of the office, the data shall be as specific as possible, and the reference
24 must be supported, when called for by the applicant, by the affidavit of
25 such employee, and such affidavit shall be subject to contradiction or

1 explanation by the affidavits of the applicant and other persons.” 37 CFR
2 §1.104(d)(2). In view of this, if this rejection is maintained on a similar
3 basis in a subsequent Action, the Examiner is respectfully requested to
4 supply such an affidavit to support this otherwise unsupported modification
5 to Bornstein.

6 Moreover, in addressing claim 7, the Action admits that Bornstein
7 does not teach or suggest “ranking individual sentences in the document by
8 treating the ordered sets of words as if they were single words”, as claim 7
9 recites. To provide this conceded missing feature, the Action points to
10 Stark’s teaching that “the program lets me count the occurrence of odds,
11 characters, or phrases”. In reliance on this teaching of counting odds,
12 characters, or phrases, the Action concludes that it would have been
13 obvious for a person of ordinary skill in the art at the time of invention to
14 have combined Stark with Bornstein because “the program lets me count
15 the occurrence of odds, characters, or phrases” would give those skilled in
16 the art tools to search documents for single words and phrases. Applicant
17 respectfully disagrees.

18 It is respectfully submitted that counting the occurrence of odds,
19 characters, or phrases, even if it provided one skilled in the art a tool to
20 search documents for single words and phrases, does not teach or suggest
21 “ranking individual sentences in the document by treating the ordered sets
22 of words as if they were single words”. Instead, counting the occurrence
23 of odds, characters, or phrases, as taught by Stark, merely results in counts,
24 or indication(s) of the number of odds, characters, or phrases in a
25 document. Combining Bornstein’s sentence ranking with Starks odd,

1 character, or phrase counts likely results in sentence rankings based on odd,
2 character, or phrase counts. Clearly, nowhere does such a result reached by
3 this combination of references teach or suggest "ranking individual
4 sentences in the document by *treating the ordered sets of words as if they*
5 *were single words*", as claim 7 recites [emphasis added].

6 For this additional reason, the 35 USC §103(a) rejection of claim 7
7 over Bornstein in view of Stark is improper and should be withdrawn.

8 **Claims 8-12** depend from claim 7 and are allowable over Bornstein
9 in view of Stark solely by virtue of this dependency.

10 Accordingly, the 35 USC §103(a) rejection of claims 8-12 is
11 improper and should be withdrawn

12 New Claims

13 New **claim 19** recites "[a] document file formed in non-volatile
14 storage as a result of the computer-implemented method recited in claim 1".
15 The features of new claim 19 are supported by the specification as filed.
16 For example, the specification at page 1, line 20 describes documents in a
17 database (i.e., non-volatile memory). Additionally, page 17, lines 3 and 4
18 describe operations of step 66 of Fig. 2, which indicate that the summary in
19 an existing document, or in a new document, is saved to memory.

20 Claim 19 depends from claim 1. For the reasons already discussed
21 above, claim 1 is not anticipated by Bornstein. Accordingly, claim 19 is
22 not anticipated by Bornstein.

23 New **claim 20** recites "[t]he method of claim 13, wherein saving the
24 document comprises saving the document into a database." The features of
25 new claim 20 are supported by the specification as filed. For example, the

1 specification at page 1, line 20 describes documents in a database.
2 Additionally, page 17, lines 3 and 4 describe operations of step 66 of Fig. 2,
3 which indicate that the summary in the existing document, or in a new
4 document, is saved to memory.

5 Claim 20 depends from claim 13. For the reasons already discussed
6 above, claim 13 is not anticipated by Bornstein. Accordingly, claim 20 is
7 not anticipated by Bornstein.

8
9 **Conclusion**

10 Pending claims 1-20 are in condition for allowance, and action to
11 that end is respectfully requested. Should any issue remain that prevents
12 allowance of the application, the Office is encouraged to contact the
13 undersigned.

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15 Respectfully submitted,

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17 Dated: 9/12/2005

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